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43. A method to offer advertisement advantages, wherein said advertisement advantage confers the ability between competing advertisers to replace at least one of each other's advertisement comprising the steps of:

creating advertisements for integration within an environment for participating users, said environment comprising any of a non-computing, partial computing, and computing environment, said advertisements of said participating users being placed within said environment such to obtain the most exposure as compared to other non-participating users, providing an advantage; and

offering said advertisements to participating users within said environment.

45. A method to transact advantages, wherein said advantages comprise selectively available environment features capable of assisting participating users to overcome at least one challenge comprising the steps of:

offering advantages, and

exchanging advantages for consideration.

REMARKS

Status of the Application

Upon entry of this amendment, Claims 44-46 will have been entered as per recognition by the Examiner of the Preliminary Amendment filed on May 1, 2001, Claims 1, 10, 21, 23, 27, 31, 35, 42, and 45 will have been amended, and, Claims 1-46 remain pending in this case. Claims 1-43 stand rejected under 35 U.S.C. §112, Second Paragraph, as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which application regards

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as the invention. Claims 1-3, 5, 6, 10-15, 20-28, 30-33, 35, 36, 38, and 39 stand rejected under 35 U.S.C. 102(b) as being allegedly anticipated by United States Patent 5,654,746 (*McMullan Jr. et al.*). Claims 4, 7-9, 16-18, 29, and 34 stand rejected under 35 U.S.C. 103(a) as being allegedly obvious over *McMullan Jr. et al.* in view of United States Patent 5,710,887 (*Chelliah et al.*). Claim 19 stands rejected under 35 U.S.C. 103(a) as being allegedly obvious over *McMullan Jr. et al.* in view of United States Patent 5,761,648 (*Golden et al.*). Claim 37 stands rejected under 35 U.S.C. 103(a) as being allegedly obvious over *McMullan Jr. et al.* Claims 40 and 41 stand rejected under 35 U.S.C. 103(a) as being allegedly obvious in view of *Chelliah et al.*.

Furthermore, on April 8, 2002, Applicant along with his under-signed attorney interviewed the Examiner to discuss the current action (Paper No. 14). During the interview, The Examiner suggested that Applicant's claims 1-43 would be allegedly obvious in light of two additional references, Pollution Trading systems and United States Patent 5,892,900 (*Ginter et al.*). (See Paper 15). However, during or subsequent to the interview, the Examiner did not provide and has not provided any specific recitation from the *Ginter et al.* reference, nor did the Examiner recite any specific Pollution Trading system to indicate how such references render Applicant's claims 1-43 obvious. Accordingly, Applicant respectfully requests further detail from the Examiner, as per MPEP §2144, to better understand which parts of these references are being asserted against Applicant's claims 1-43 to better formulate a response.

Further to the April 8, 2002 Examiner Interview and concurrent with the filing of this response, Applicant offers proof, attached hereto as per U.S.P.T.O. procedures, of filing of a

Preliminary Amendment filed on May 1, 2002. Applicant respectfully requests that the Examiner enter the Preliminary Amendment without prejudice and without haste. Moreover, Applicant would like to note for the record that newly added Claims 44-46 of the Preliminary Amendment were not offered to traverse any rejections but merely to obtain protection for disclosed but unclaimed subject matter of the originally filed application. As such, Claims 44-46 are not offered for patentability purposes.

In view of the foregoing amendments and following remarks, Applicant respectfully requests reconsideration of the present application and an early Notice of Allowance.

35 U.S.C. § 112, Paragraph 2 Rejection

The Examiner has rejected Claims 1-43 as being allegedly indefinite for failing to point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner suggests that the terms “desirable”, “advantages”, “indicative”, “preferred”, “considered desirable”, “seamless”, higher level of success”, and “willing” are relative terms which render the claim indefinite. The Examiner states that the terms are not defined by the claim, and the specification does not provide a standard for ascertaining the requisite degree [of the term]. The Examiner goes further to suggest that one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

As M.P.E.P § 2174 states, “the primary purpose of the [paragraph 2] requirement of definiteness of claim language is to ensure that the scope of the claims is clear so that the public

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is informed of the boundaries of what constitutes infringement of the patent. A secondary purpose is to provide a clear measure of what applicants regard as the invention so that it can be determined whether the claimed invention meets all the criteria for patentability and whether the specification meets the criteria of 35 U.S.C. 112, first paragraph with respect to the claimed invention." Furthermore, Applicant respectfully reminds The Examiner that a fundamental principle contained in 35 U.S.C. § 112, second paragraph is that applicants are their own lexicographers. M.P.E.P. § 2173.01. As such applicants can define in the claims that they regard as their invention essentially in whatever terms they choose so long as the terms are not used in ways that are contrary to accepted meanings in the art. Specifically, applicant may use functional language, alternative expressions, negative limitations, or *any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought*. M.P.E.P. § 2173.01.

Applying the foregoing to the objected-to claim terms, Applicant respectfully submits that the terms of Claims 1-43 are definite since the scope of the terms of Claims 1-43 are clear so that the public is informed of the boundaries of what constitutes infringement of the patent.

However, in an effort to more quickly bring this case into allowance, Applicant has amended the pending independent claims (Claims 1, 11, 21, 23, 27, 31, 35, 42, and 45) of the present application to address § 112, paragraph 2 rejections. Specifically, Applicant has amended the independent claims to provide more detail with respect to the objected-to claim terms and to more clearly recite the objected-to claim terms.

From the foregoing, it is appreciated that claims 1-43 of the present application meet the

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requirements of 35 U.S.C. § 112, second paragraph. On this basis, Applicant respectfully requests that the 35 U.S.C. § 112, second paragraph rejection be withdrawn.

35 U.S.C. § 102(b) Rejection

The Examiner has rejected claims 1-3, 5, 6, 10-15, 20-28, 30-33, 35, 36, 38, and 39 as being allegedly anticipated by *McMullan Jr. et al.* Applicants respectfully submit that the standard when determining whether a reference is anticipatory is: "... ***if the reference discloses, either expressly or inherently, every limitation of the claim.***" *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987). Moreover, "***[a]bsence from the reference of any claimed element negates anticipation.***" *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571, 230 U.S.P.Q. 81, 84 (Fed. Cir. 1986).

Applicant respectfully disagrees with the anticipatory nature of the *McMullan Jr. et al.* reference. Specifically, the present application claims a system and methods allowing for the creation, integration, and transaction of advantages in non-computing, partial computing, and computing environments wherein participating content providers (and/or advertisers) can create advantages and integrate the advantages in a particular environment. Furthermore, the advantages may be transacted in the environment with participating users in real time using a billing system that relies on pre-established user accounts.

In contrast to the subject matter of Applicant's claims 1-43, however, the systems and methods taught by *McMullan et al.* **do not teach a system or methods that contemplate the**

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creation of advantages that can be integrated and subsequently transacted in environments. Furthermore, *McMullan Jr. et al* do not teach the creation and integration of advantages in partial and non-computing environments. (See Claims 1-43 of the present application). Specifically, *McMullan Jr. et al.* do not teach the creation and integration of advertisement advantages. (Claims 42-43).

Rather, *McMullan Jr. et al.* teach a communication system for the delivery of digital data programs to remote location that includes a transmitter for transmitting a signal containing therein the digital data programs and a communications terminal located at the remote location. (See *McMullan Jr. et al.* ABSTRACT).

The Examiner suggests that the delivery of digital data over a communications network is the same as the creation and integration of advantages. Applicant respectfully disagrees with such analogy as the term advantages is specifically defined as a 'feature or element within an environment that one does not have access to that provides an edge in overcoming a presented challenge.' Page 1, Lines 22-24 of the Present Application. Applicant respectfully submits that delivery of digital content is not an advantage as contemplated by the present application since it does not assist anyone in overcoming a challenge. Furthermore, the delivery of digital content to remote users does not provide a feature or element within an environment that one is **not** intended to have. Rather, the teachings of *McMullan Jr. et al.* are exactly opposite to this operation such that users are often provided with elements that they **are** intended to have (e.g. pay per view movies).

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Furthermore, The Examiner has rejected claims 42 and 43 as being allegedly anticipated by *Chelliah et al.* The Examiner suggests that *Chelliah et al.* use target advertising in their electronic shopping environment to offer advertisements to participating users. The Examiner equates targeted advertising to Applicant's recitation of offering advertisement advantages. Applicant respectfully disagrees with the Examiner's contention on the basis that targeted advertising does not rise to the level of an advertising advantage. Specifically, an advertisement advantage, in the context of the present application, is an ability conferred to competing advertisers to not only bid for the placement of advertisements but to bid for the ability to overtake at least one of each other's already placed advertisements. *Chelliah et al.* simply do not explicitly or inherently teach such an advertisement advantage.

From the foregoing it is clear that the *McMullan Jr. et al.* and *Chelliah et al.* references are not anticipatory as they does not teach every limitation of the claims of the present application. On this basis, Applicant respectfully requests that this rejection be withdrawn.

35 U.S.C. § 103(a) Rejections

Prima Facie Obviousness

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Further, there must be a reasonable expectation of success after combining the references the intended purpose

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of the invention is realized. **Lastly, the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Applicant respectfully submits that a *prima facie* case of obviousness has not been made for claims 1-43 of the present application.

The Present Invention

The present invention provides a system and methods allowing for the creation, integration, and transaction of advantages in non-computing, partial computing, and computing environments wherein participating content providers (and/or advertisers) can create advantages and integrate the advantages in a particular environment. Furthermore, the advantages may be transacted in the environment with participating users in real time using a billing system that relies on pre-established user accounts. Lastly, the present invention contemplates the selected placement of advertisements as an advantage that may be integrated and transacted within a given environment.

McMullan Jr. et al. in view of Chelliah et al.

The Examiner has rejected claims 4, 7-9, 16-18, 29,34, 37, 40 and 41 as being allegedly obvious over *McMullan Jr. et al.* in view of *Chelliah et al.*. *McMullan et al* disclose a

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communications system for the delivery of digital data programs to remote locations that includes a transmitter for transmitting a signal having the digital data programs and a communications terminal located at the remote location. The communications terminal includes a control circuit including authorizing circuitry responsive to authorization data for authorizing the communications terminal to access an authorized one of the digital data programs in one of a first a second authorization mode.

In contrast to the inventions of Applicant's claims 4, 7-9, 16-18, 29, and 34, however, the systems and methods taught by *McMullan Jr. et al.* **do not teach a system or methods that contemplate the creation of advantages that can be integrated and subsequently transacted in environments. Furthermore, *McMullan Jr. et al* do not teach the creation and integration of advantages in partial and non-computing environments.** (See Claims 1-43 of the present application). Rather, *McMullan Jr. et al.* teach a communication system for the delivery of digital data programs to remote location that includes a transmitter for transmitting a signal containing therein the digital data programs and a communications terminal located at the remote location. (See *McMullan Jr. et al.* ABSTRACT).

The Examiner suggests that the delivery of digital data over a communications network is the same as the creation and integration of advantages. Applicant respectfully disagrees with such analogy as the term advantages is specifically defined as a "feature or element within an environment that one is not intended to have or does not normally have access to that provides an edge in overcoming a presented challenge." Page 1, Lines 22-24 of the Present Application.

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Applicant respectfully submits that delivery of digital content is not an advantage as contemplated by the present application since it does not assist anyone in overcoming a challenge. Furthermore, the delivery of digital content to remote users does not provide a feature or element within an environment that one is **not** intended to have. Rather, the teachings of *McMullan Jr. et al.* are exactly opposite to this operation such that users are often provided with elements that they **are** intended to have (e.g. pay per view movies).

Comparatively, *Chelliah et al.* disclose a system for facilitating commercial transactions over a computer driven network capable of providing communications between a supplier and at least one customer site associated with each customer and including an input means and a display.

In contrast to the inventions of Applicant's claims 4, 7-9, 16-18, 29, 34, 37, 40 and 41 however, the systems and methods taught by *Chelliah et al.* **do not teach a system or methods that contemplate the creation of advantages that can be integrated and subsequently transacted in environments. Furthermore, *Chelliah et al.* do not teach the creation and integration of advantages in partial and non-computing environments.** (See Claims 1-43 of the present application). Rather, *Chelliah. et al.* teach a communication system that facilitates commercial transactions over computer network.

The Examiner suggests that *Chelliah et al.* teach displaying account information and providing customers with a bill summary (pages 6-7 of Paper 14). Furthermore, The Examiner suggests that *Chelliah et al.* teach narrowcast advertising that allow particular users to benefit

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from price adjustments *Id.* Even if The Examiner's contentions are correct, *Chelliah et al* fall significantly short of teaching the limitations of the present application. ***Specifically, Chelliah et al. do not teach the creation and integration of advantages (including advertising advantages) in a given environment.***

McMullan Jr. et al. and Chelliah et al. simply do not teach or even suggest the creation and integration of advantages in a given environment. Furthermore, McMullan et al. and Chelliah et al. do not teach the creation, integration, and transaction of advantages in non-computing and partial computing environments..

As *McMullan Jr. et al.* and *Chelliah et al.* do not teach every limitation of the present invention, a *prima facie* case of obviousness has not been made. Moreover, Applicant submits that the present invention is not obvious over the *McMullan Jr. et al.* reference when combined with *Chelliah et al.* since there is no motivation in the *McMullan Jr. et al.* reference to combine with *Chelliah et al.*. Specifically, *McMullan Jr. et al.* is directed to a communications system for transmitting digital data to remote locations and managing the authorization of such transmissions (Summary of the Invention). The present invention, as stated, is directed **creating and integrating advantages**. One of ordinary skill in the art would find it difficult to, refer to, yet alone, combine the teachings found in *McMullan Jr. et al.* with the *Chelliah et al.* to teach the present invention. Further, even if the *McMullan Jr. et al.* reference is combined with *Chelliah et al.*, the present invention is not obvious over these herein described references since these herein described references, alone, or in combination **fail to teach every limitation of the present invention**. For these reasons, Applicant respectfully requests that the obviousness

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rejection be withdrawn.

McMullan Jr. et al. in view of Golden et al.

The Examiner has rejected claim 19 as being allegedly obvious over *McMullan Jr. et al.* in view of *Golden et al.* *Golden et al.* disclose a data processing system and method permitting customers to access a database online and use electronic certificates. The data processing system identifies and marks each electronic certificate with a code distinguishing it from all other certificates and with another code identifying the user. In addition, the data processing system permits coupon issuers to go online as well to create the certificate and specify controls that redirect the total number of certificates issues as well as the number to be issued. (Cols. 1 and 2, Lines 66-67, and 1-8, respectively).

In contrast to the inventions of Applicant's claims 19, however, the systems and methods taught by *Golden et al.* **do not teach a system or methods that contemplate the creation of advantages that can be integrated and subsequently transacted in environments.** Furthermore, *Golden et al.* **do not teach the creation and integration of advantages in partial and non-computing environments.** (See Claims 1-43 of the present application). Rather, *Golden et al.* teach a data processing system that manage and transact electronic certificates. The Examiner suggests that *Golden et al.* teach interactive coupons.

Even if The Examiner's contentions are correct, *Golden et al.* fall significantly short of teaching the limitations of the present application. ***Specifically, Golden et al. do not teach the***

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creation and integration of advantages (including advertising advantages) in a given environment.

Comparatively, and as stated above, *McMullan et al* disclose a communications system for the delivery of digital data programs to remote locations that includes a transmitter for transmitting a signal having the digital data programs and a communications terminal located at the remote location. The communications terminal includes a control circuit including authorizing circuitry responsive to authorization data for authorizing the communications terminal to access an authorized one of the digital data programs in one of a first a second authorization mode.

In contrast to the inventions of Applicant's claim 19, however, the systems and methods taught by *McMullan Jr. et al.* **do not teach a system or methods that contemplate the creation of advantages that can be integrated and subsequently transacted in environments.** Furthermore, *McMullan Jr. et al* **do not teach the creation and integration of advantages in partial and non-computing environments.** (See Claims 1-43 of the present application). Rather, *McMullan Jr. et al.* teach a communication system for the delivery of digital data programs to remote location that includes a transmitter for transmitting a signal containing therein the digital data programs and a communications terminal located at the remote location. (See *McMullan Jr. et al.* ABSTRACT).

As *Golden et al.* do not teach every limitation of the present invention, a *prima facie* case of obviousness has not been made. Moreover, Applicant submits that the present invention is

not obvious over the *Golden et al.* reference when combined with the other herein described cited references since there is no motivation in the *Golden et al.* reference to combine with the other herein described references. *Golden et al.* is directed to a system and methods for creating, managing, and transacting electronic certificates. The present invention, as stated, is directed to the creation and integration of advantages. One of ordinary skill in the art would find it difficult to, refer to, yet alone, combine the teachings found in *Golden et al.* with the other herein described references to teach the present invention. Further, even if the *Golden et al.* reference is combined with the other herein described references, the present invention is not obvious over these herein described references since these herein described references, alone, or in combination **fail to teach every limitation of the present invention**. For these reasons, Applicant respectfully requests that the obviousness rejection be withdrawn.

Claim Analysis:

Independent Claims 1, 10, 21, 31, 40, and 42:

The Examiner **has not** rejected independent claims 1, 10, 21, 31, 40, and 42, as being obvious. Accordingly, Applicant respectfully submits that inasmuch as dependent claims 2--9, 11-20, 22-30, 32-39, 41, 43 depend either directly or indirectly from independent claims 1, 10, 21, 31, 40, and 42, that these dependent claims too patentably define over the prior art of record for the reasons stated above.

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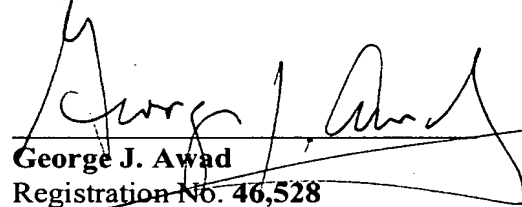
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CONCLUSION

For all the foregoing reasons, Applicant respectfully submits that claims 1-46 patentably define over the prior art of record. Reconsideration of the present Office Action and an early Notice of Allowance are respectfully requested.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "Version With Markings To Show Changes Made."

Respectfully submitted,



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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims:

Please amend the claims as follows:

1. (Amended) A system [to provide desired] providing selectively available environment features and/or elements to participating users [operating in preferred environments] comprising:

an integration system, said integration system capable of integrating [desired] selectively available environment features and/or elements into user environments;

a communication system, said communication system allowing participating users to communicate [accepted] the acceptance of [offered] environment features and/or elements to said integration system; and

a transaction system, said transaction system cooperating with said integration system and said communication system to transact said accepted [offered] selectively available environment features and/or elements.

10. (Amended) A method to provide and transact [desired] selectively available environment features and/or elements to participating users [in preferred environments], comprising the steps of:

(c) creating [desired] selectively available environment features and/or elements, wherein said selectively available environment features and/or elements affording said participating users access to otherwise inaccessible abilities within [said preferred] a given environment[s];

(d) integrating said created [desired] selectively available environment features and/or elements into said [preferred] environment[s] such that a [desired] a selectively available environment feature and/or element is offered to said participating users in said [preferred] given environment[s];

(c) executing [desired] selectively available environment features and/or elements

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upon the acceptance of said offered [desired] selectively available environment features and/or elements;

(e) tracking the acceptance of said [desired] selectively available environment features and/or elements for said participating users; and

(e) transacting said executed [desired] selectively available environment features and/or elements.

21. (Amended) A system for identifying, creating, integrating and transacting advantages, wherein said advantages comprise selectively available environment features capable of assisting participating users to overcome at least one challenge, comprising:

(c) at least one computing environment, said computing environment comprising various challenges;

(b) a means for offering, integrating, and delivering created advantages to said participating users, said created advantages allowing said participating users to more easily overcome said challenges;

a means for tracking requests of said offered advantages by said participating users;

(d) a means for charging consideration to said participating users for the use of said advantages; and

(e) a means for collecting said consideration from said participating [users for requested advantages].

23. (Amended) A method to integrate advantages, wherein said advantages comprise selectively available environment features capable of assisting participating users to overcome at least one challenge, comprising the steps of:

creating advantages; and

incorporating said advantages into an environment, said environment comprising any of a non-computing, a partial computing, and a computing environment.

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27. (Amended) A method to transact integrated advantages, wherein said advantages comprise selectively available environment features capable of assisting participating users to overcome at least one challenge, comprising:

- (a) tracking the usage of offered integrated advantages; and
- (b) charging for used integrated advantages.

31. (Amended) A system to transact integrated advantages, wherein said advantages comprise selectively available environment features capable of assisting participating users to overcome at least one challenge comprising:

- an advantage offering system;
- an account system; and
- a billing system.

35. (Amended) A method comprising the acts of:

- (a) providing a computer gaming environment in which an advantage, wherein said advantages comprise selectively available environment features capable of assisting participating users to overcome at least one challenge, is available to a user;
 - (b) receiving an indication by the user that he or she is willing to acquire the advantage;
- and
- (c) providing the advantage to the user.

40. (Amended) A system to provide integrated advertisement advantages, wherein said advertisement advantage confers the ability between competing advertisers to replace at least one of each other's advertisement comprising:

- an advantages offering system, said advantages offering system allowing for the creation and integration of advertisements within an environment, said environment comprising

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any of a non-computing, partial computing, and computing environments; and

an advantages transaction system, said advantages transaction system capable of pricing, charging, billing, and collecting for the creation and integration of advertisements within said environment.

43. (Amended) A method to offer advertisement advantages, wherein said advertisement advantage confers the ability between competing advertisers to replace at least one of each other's advertisement comprising the steps of:

creating advertisements for integration within an environment for participating users, said environment comprising any of a non-computing, partial computing, and computing environment, said advertisements of said participating users being placed within said environment such to obtain the most exposure as compared to other non-participating users, providing an advantage; and

offering said advertisements to participating users within said environment.

45. (Amended) A method to transact advantages, wherein said advantages comprise selectively available environment features capable of assisting participating users to overcome at least one challenge comprising the steps of:

offering advantages; and

exchanging advantages for consideration.